

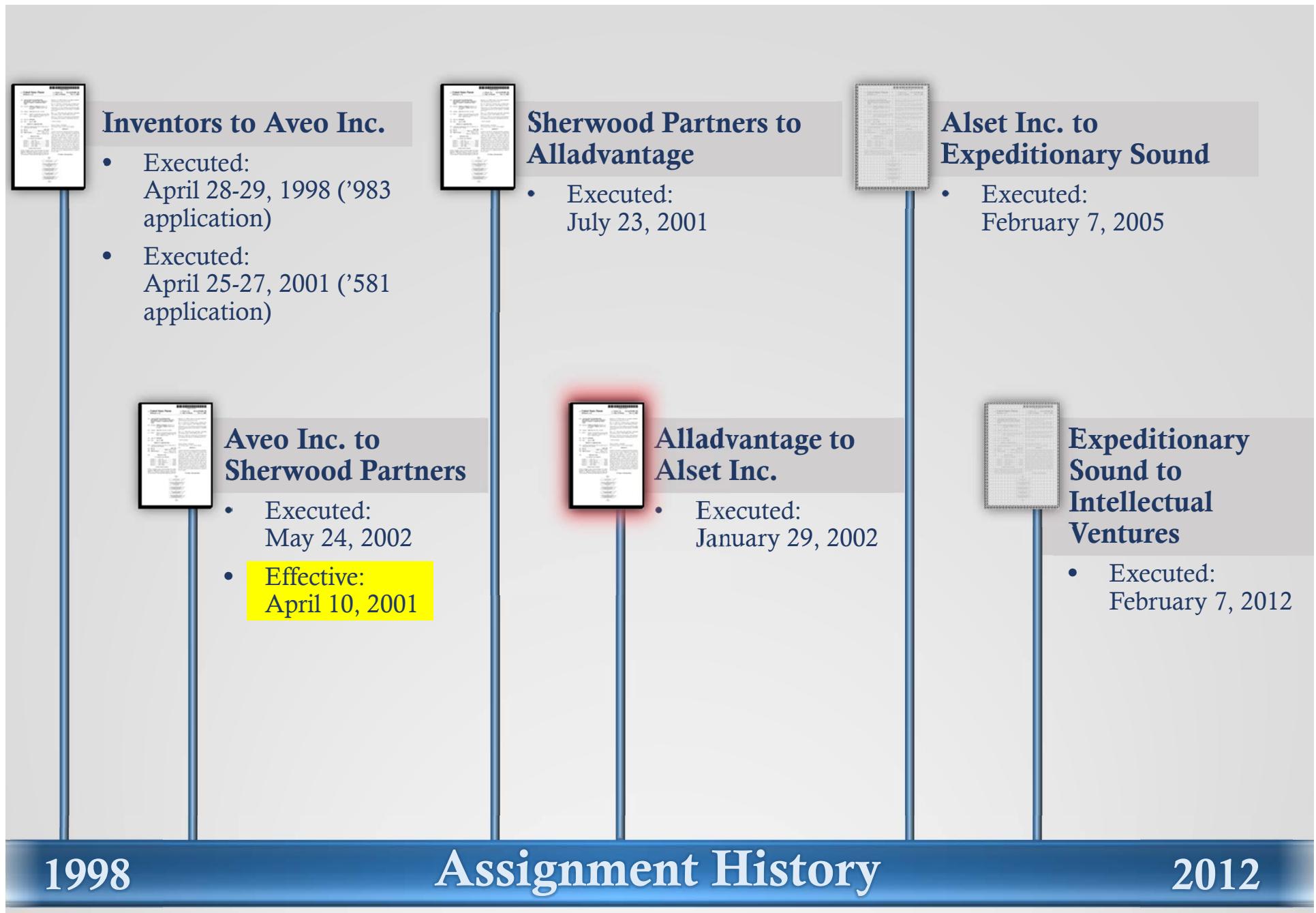
Intellectual Ventures I LLC et al.  
v.  
Erie Indemnity Co. et al. and  
Highmark, Inc. et al.

1:14-cv-00220, 2:14-cv-01131 (W.D. Pa.)

Rule 12(b)(1) Motion to Dismiss  
Due to Lack of Standing  
April 14, 2015

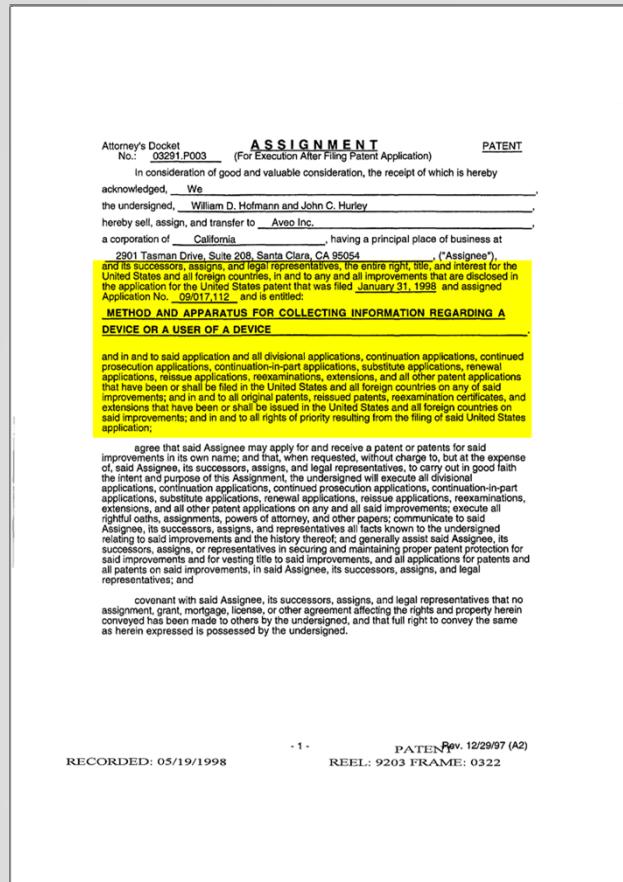
# Organization

- Assignment History
- Language in AllAdvantage to Alset Patent Assignment was insufficient to transfer the '581 patent
- Parol Evidence should not be admitted, and the evidence offered by IV does not Support the Transfer of the '581 patent



# Assignment 1a: 1998 Inventors to Aveo, Inc. '983 Application

- Identifies the '983 application (parent to the '581 patent) by title and application number



and its successors, assigns, and legal representatives, the entire right, title, and interest for the United States and all foreign countries, in and to any and all improvements that are disclosed in the application for the United States patent that was filed January 31, 1998 and assigned Application No. 09/017,112, and is entitled:

## **METHOD AND APPARATUS FOR COLLECTING INFORMATION REGARDING A DEVICE OR A USER OF A DEVICE**

and in and to said application and all divisional applications, continuation applications, continued prosecution applications, continuation-in-part applications, substitute applications, renewal applications, reissue applications, reexaminations, extensions, and all other patent applications that have been or shall be filed in the United States and all foreign countries on any of said improvements; and in and to all original patents, reissued patents, reexamination certificates, and extensions that have been or shall be issued in the United States and all foreign countries on said improvements; and in and to all rights of priority resulting from the filing of said United States application;

Ex. 2 to Defendants' 12(b)(1) Motion to Dismiss at 4

# Assignment 1a: 1998 Inventors to Aveo, Inc. '983 Application

- Also specifically assigns all continuation applications derived from the '983 application

Attorney's Docket **A S S I G N M E N T** PATENT  
 No.: **03291.P003** (For Execution After Filing Patent Application)

In consideration of good and valuable consideration, the receipt of which is hereby acknowledged, We  
 the undersigned, William D. Hofmann and John C. Hurley, hereby sell, assign, and transfer to Aveo Inc., a corporation of California, having a principal place of business at 2901 Tasman Drive, Suite 208, Santa Clara, CA 95054, and its successors, assigns, and legal representatives, the entire right, title, and interest for the Undiscovered Country, in and to all and all improvements that may be disclosed in the application for the United States patent that was filed January 31, 1998 and assigned Application No. 09/17,112, and is entitled:  
**METHOD AND APPARATUS FOR COLLECTING INFORMATION REGARDING A DEVICE OR A USER OF A DEVICE**

and in and to said application and all divisional applications, continuation applications, continued prosecution applications, continuation-in-part applications, substitute applications, renewal applications, reissue applications, reexaminations, extensions, and all other patent applications that have been or shall be filed in the United States and all foreign countries on said improvements; and in and to all original patents, reissued patents, reexamination certificates, and extensions that have been or shall be issued in the United States and all foreign countries on said improvements; and in and to all rights of priority resulting from the filing of said United States application;

agree that said Assignee may apply for and receive a patent or patents for said improvements in its own name; and when so requested, without charge to, but at the expense of, said Assignee, its successors, assigns, and legal representatives, in good faith in the intent and purpose of this Assignment, the undersigned will execute all divisional applications, continuation applications, continued prosecution applications, continuation-in-part applications, substitute applications, reissue applications, reexamination certificates, extensions, and all other patent applications for any and all said improvements, execute all rightful oaths, assignments, powers of attorney, and other papers, necessary to said Assignee, its successors, assigns, and legal representatives all facts known to the undersigned relating to said improvements, and the general nature of the same, and to said Assignee, its successors, assigns, or representatives in securing and maintaining proper patent protection for said improvements and for vesting title to said improvements, and all applications for patents and all patents on said improvements, in said Assignee, its successors, assigns, and legal representatives; and

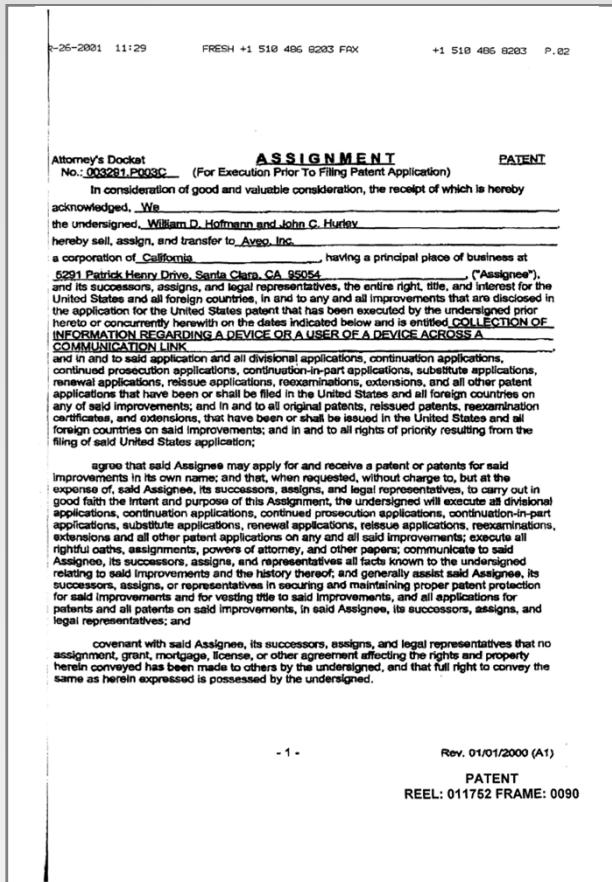
covenant with said Assignee, its successors, assigns, and legal representatives that no assignment, grant, mortgage, license, or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

and in and to said application and all divisional applications, continuation applications,

Ex. 2 to Defendants' 12(b)(1) Motion  
to Dismiss at 4

# Assignment 1b: 2001 Inventors to Aveo, Inc. '581 Application

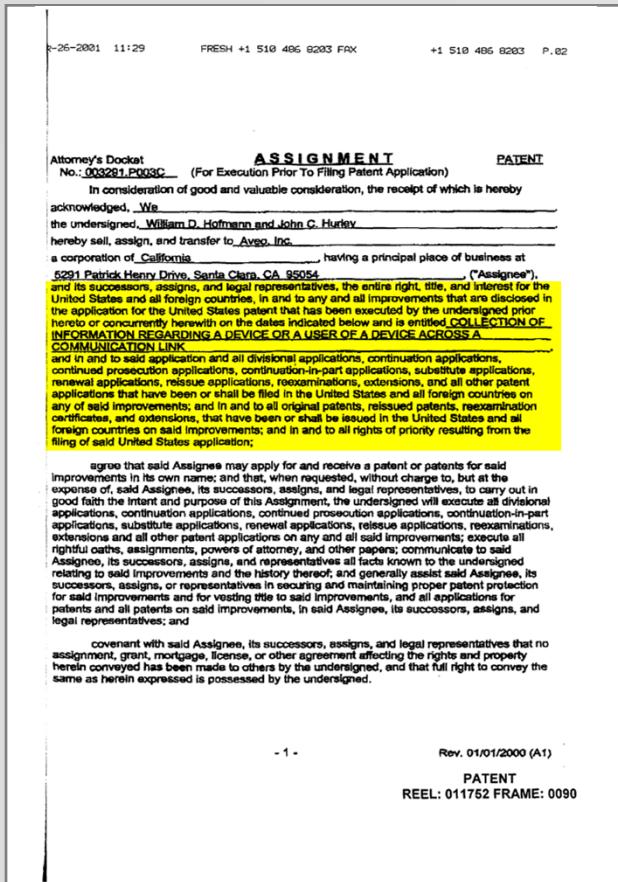
- 2001 Assignment from co-inventors Hoffman and Hurley to Aveo, Inc.



Ex. 3 to Defendants' 12(b)(1)  
Motion to Dismiss at 5

# Assignment 1b: 2001 Inventors to Aveo, Inc. '581 Application

- Identifies the '581 application by title and application number

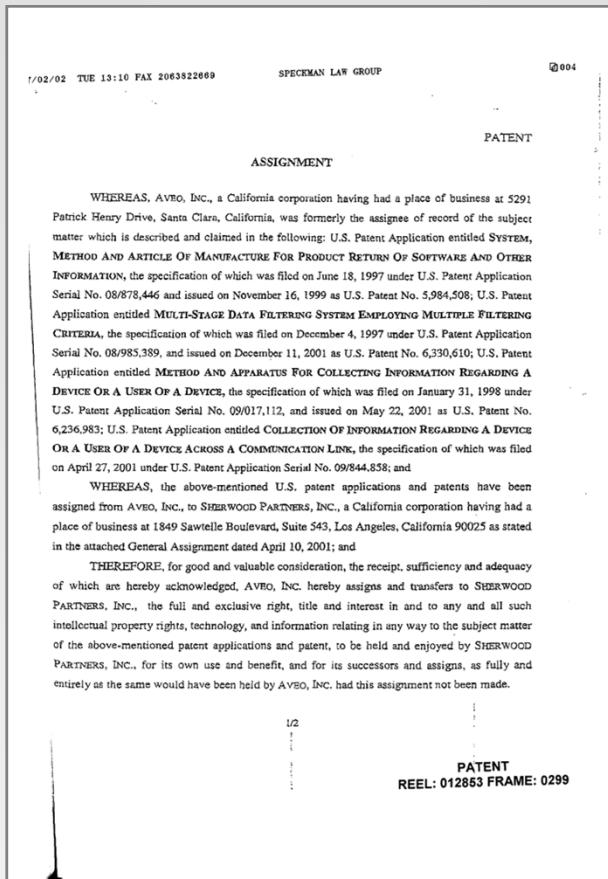


and its successors, assigns, and legal representatives, the entire right, title, and interest for the United States and all foreign countries, in and to any and all improvements that are disclosed in the application for the United States patent that has been executed by the undersigned prior hereto or concurrently herewith on the dates indicated below and is entitled **COLLECTION OF INFORMATION REGARDING A DEVICE OR A USER OF A DEVICE ACROSS A COMMUNICATION LINK**, and in and to said application and all divisional applications, continuation applications, continued prosecution applications, continuation-in-part applications, substitute applications, renewal applications, reissue applications, reexaminations, extensions, and all other patent applications that have been or shall be filed in the United States and all foreign countries on any of said improvements; and in and to all original patents, reissued patents, reexamination certificates, and extensions, that have been or shall be issued in the United States and all foreign countries on said improvements; and in and to all rights of priority resulting from the filing of said United States application;

Ex. 3 to Defendants' 12(b)(1) Motion to Dismiss at 5

# Assignment 2: Aveo, Inc. to Sherwood Partners

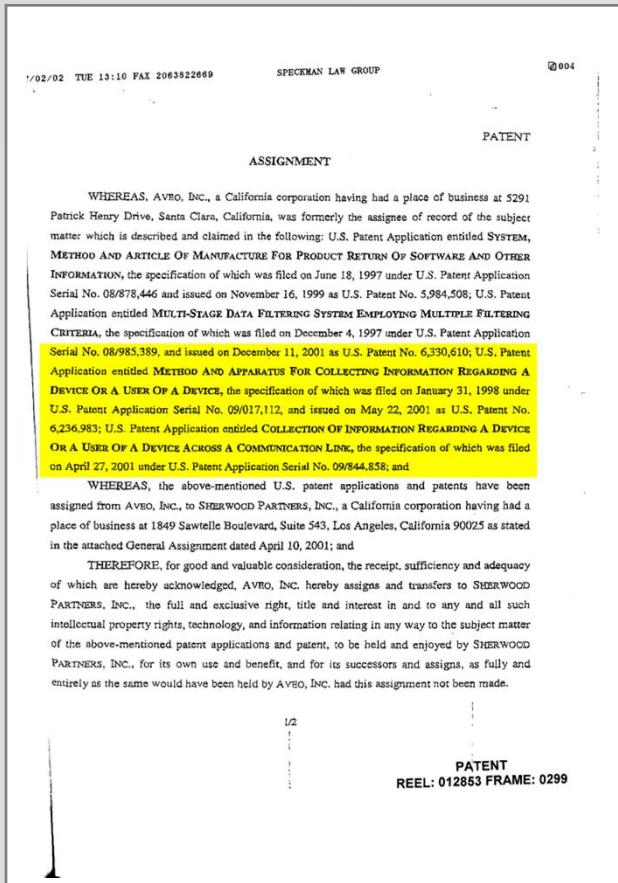
- Nunc Pro Tunc assignment executed May 24, 2002, effective as of April 10, 2001



Ex. 4 to Defendants' 12(b)(1)  
Motion to Dismiss at 8

# Assignment 2: Aveo Inc. to Sherwood Partners

- Identifies the '581 Application and the '983 patent by Title, Application Number, and File Date

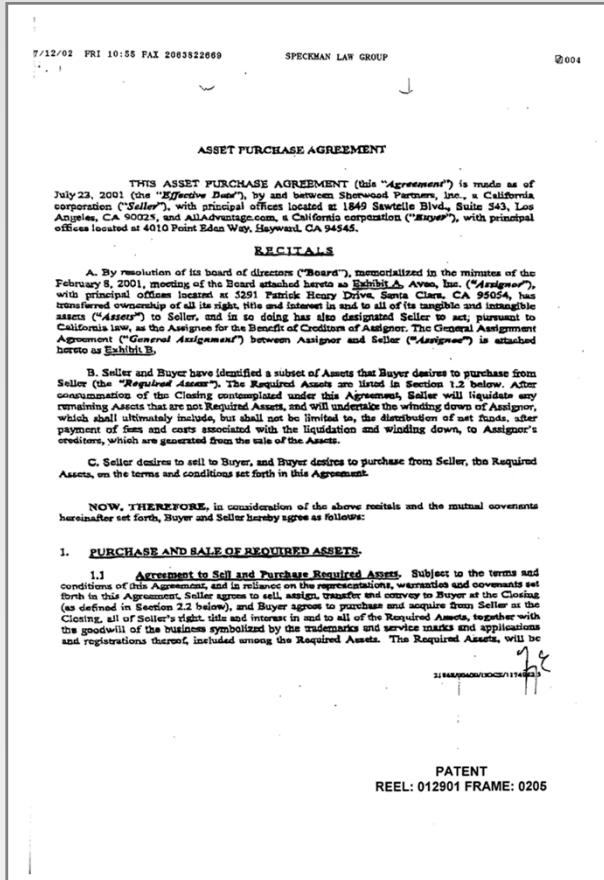


Serial No. 08/985,389, and issued on December 11, 2001 as U.S. Patent No. 6,330,610; U.S. Patent Application entitled **METHOD AND APPARATUS FOR COLLECTING INFORMATION REGARDING A DEVICE OR A USER OF A DEVICE**, the specification of which was filed on January 31, 1998 under U.S. Patent Application Serial No. 09/017,112, and issued on May 22, 2001 as U.S. Patent No. 6,236,983; U.S. Patent Application entitled **COLLECTION OF INFORMATION REGARDING A DEVICE OR A USER OF A DEVICE ACROSS A COMMUNICATION LINK**, the specification of which was filed on April 27, 2001 under U.S. Patent Application Serial No. 09/844,858; and

Ex. 4 to Defendants' 12(b)(1) Motion to Dismiss at 8

# Assignment 3: Sherwood Partners to AllAdvantage.com

- Asset Purchase Agreement executed July 23, 2001 between Sherwood Partners and AllAdvantage.com.



Ex. 5 to Defendants' 12(b)(1)  
Motion to Dismiss at 5

# Assignment 3: Sherwood Partners to AllAdvantage.com

- Assigns a list of 18 patents and applications. The '581 application is not listed.

Ex. 5 to Defendants' 12(b)(1)  
Motion to Dismiss at 8

2/02 FRI 10:56 FAX 2053522869

SPECKMAN LAW GROUP

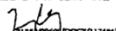
0008

Multi-Stage Data Filtering for Preserving User Privacy.	Pending	98959614.3
Method and Apparatus for Attribute-Based Addressing.	Pending	09/017,114
Method and Apparatus for Attribute-Based Addressing.	Pending	25623/99
Method and Apparatus for Attribute-Based Addressing.	Pending	99905473.9
Collecting Information About a Computer or Its User	Pending	14774/99
Collecting Information About a Computer or Its User	Pending	2318852
Collecting Information About a Computer or Its User	Pending	99904362.3
Multi-Stage Data Filtering on a Single System	Pending	09/198,337
Multi-Stage Data Filtering on a Single System	Pending	16231/99
Multi-Stage Data Filtering on a Single System	Pending	2312705
Multi-Stage Data Filtering on a Single System	Pending	98960689.2
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Pending	2,294,124
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Pending	98931419.0
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Issued	5,084,508
Method and Apparatus for Collecting Information regarding a Device or a User of a Device.	Issued	6,236,983

**1.3. Asset Transfer: Passage of Title, Delivery.**

(a) **Title Passage.** Except as otherwise provided in this Section, upon the Closing, title to all of the Required Assets shall pass to Buyer, and Seller shall deliver

-5-


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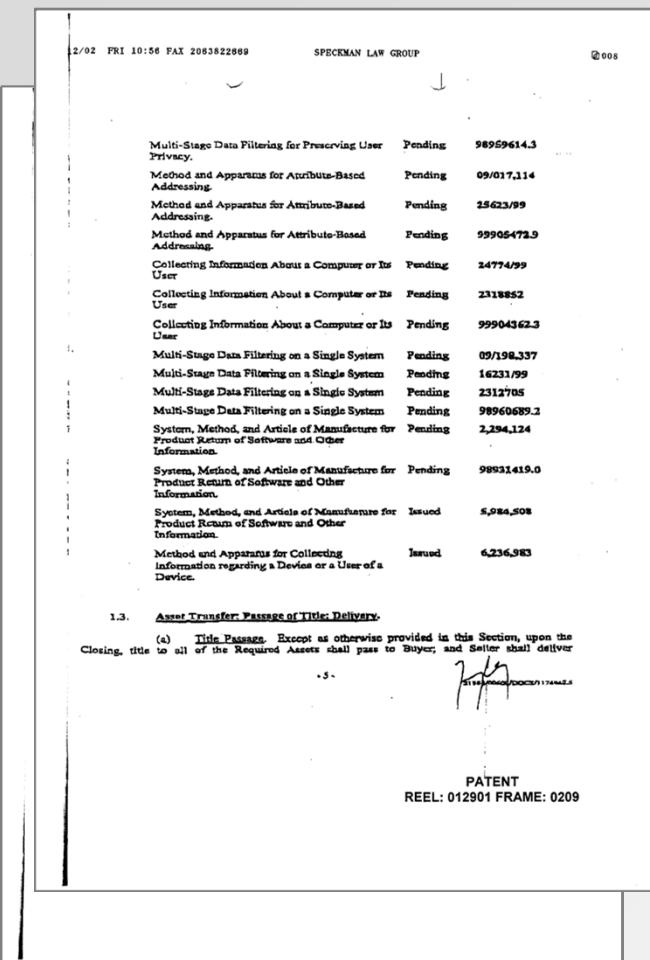
PATENT

REEL: 012901 FRAME: 0209

Ex. 5 to Defendants' 12(b)(1)  
Motion to Dismiss at 9

# Assignment 3: Sherwood Partners to AllAdvantage.com

- Identifies the '983 patent by title and patent number



Title	Status	Serial number/ Patent number
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	08/985,389
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	15377/99
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	2312704
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	98959614.3
Method and Apparatus for Attribute-Based Addressing.	Pending	09/017,114
Method and Apparatus for Attribute-Based Addressing.	Pending	25623/99
Method and Apparatus for Attribute-Based Addressing.	Pending	99905472.9
Collecting Information About a Computer or Its User	Pending	24774/99
Collecting Information About a Computer or Its User	Pending	2318852
Collecting Information About a Computer or Its User	Pending	99904362.3
Multi-Stage Data Filtering on a Single System	Pending	09/198,337
Multi-Stage Data Filtering on a Single System	Pending	16231/99
Multi-Stage Data Filtering on a Single System	Pending	2312705

**Method and Apparatus for Collecting Information regarding a Device or a User of a Device.**

**Issued**

**6,236,983**

System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Issued	5,984,508
Method and Apparatus for Collecting Information regarding a Device or a User of a Device.	Issued	6,236,983

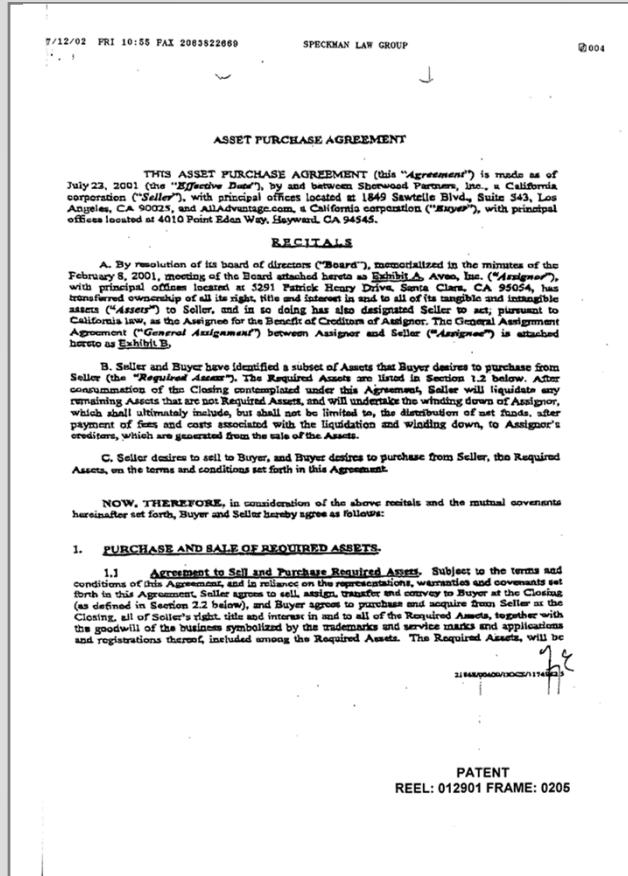
Ex. 5 to Defendants' 12(b)(1) Motion to Dismiss at 8-9

Defendants' Rule 12(b)(1) Motion to Dismiss Presentation



# Assignment 3: Sherwood Partners to AllAdvantage.com

- Parties expressly agreed to assign “any continuations” of the listed patents.



**1.2.4 Patents** (i) All patents and patent applications, including but not limited to the patents and patent applications listed in the table below; (ii) any continuation, continuation-in-part, division, reissue, reexamination, extension, renewal or substitute of the patents and patent applications of subsection (i); (iii) any patent or application claiming priority from any of the items listed under subsections (i) to (ii); (iv) any foreign (non-U.S.) counterpart patent or patent application that claims priority to or from any of the items listed under subsections (i) to (iii); as well as related patent rights arising from subsections (i) to (iv).

Ex. 5 to Defendants' 12(b)(1) Motion to Dismiss at 5

# Assignment 4: AllAdvantage.com to Alset, Inc.

- Executed January 29, 2002.

02/02 TUE 13:38 FAX 2063822669 SPECKMAN LAW GROUP 004

**PATENT ASSIGNMENT**

WHEREAS, AllAdvantage.com, a California corporation ("Assignor"), having its place of business at 4010 Point Eden Way Hayward, CA 94545, is the owner of the following patents and patent applications:

Patent Title	Status	Serial Number/ Patent Number
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	08/985,389
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	15377/99
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	2312704
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	98959614.3
Method and Apparatus for Attribute-Based Addressing.	Pending	25623/99
Method and Apparatus for Attribute-Based Addressing.	Pending	99905472.9
Collecting Information About a Computer or Its User.	Pending	24774/99
Collecting Information About a Computer or Its User.	Pending	2318852
Collecting Information About a Computer or Its User.	Pending	99904362.3
Multi-Stage Data Filtering on a Single System.	Pending	09/198,337
Multi-Stage Data Filtering on a Single System.	Pending	16231/99
Multi-Stage Data Filtering on a Single System.	Pending	2312705
Multi-Stage Data Filtering on a Single System.	Pending	98960689.2
System, Method, and Article of Manufacture for Product Return of	Pending	2,294,124

**PATENT**  
REEL: 012853 FRAME: 0311

Ex. 1 to Defendants' 12(b)(1)  
Motion to Dismiss at 5

02/02 TUE 13:39 FAX 2063822669 SPECKMAN LAW GROUP 005

Software and Other Information.

System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Pending	98931419.0
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Issued	5,984,508
Method and Apparatus for Collecting Information regarding a Device or a User of a Device.	Issued	6,236,983

**Specific Patent Rights**

All rights for the pending patent reflected in the following, *unintentionally abandoned* patent application, together with any and all rights that might exist in such application through any petition to revive Buyer may wish to file with the United States Patent and Trademark Office:

Method and Apparatus for Attribute-Based Addressing.	Pending	09/017,114
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WHEREAS, Alset Inc., a Delaware corporation ("Assignee"), having its principal place of business at 555 El Camino Real, Suite 307, Palo Alto, CA 94301, is desirous of acquiring said patents, NOW, THEREFORE, in good and valuable consideration whereof, it is hereby acknowledged, Assignor, does hereby assign unto Assignee, all rights, including common law rights, title and interest in the United States of America, Canada, the European Union, and all other countries and jurisdictions of the world in and to said patents together with the goodwill of the business symbolized by said patents and applications and registrations thereof.

Assignor also grants Assignee a limited power of attorney, for the sole purpose of executing any and all documentation that might be necessary to effect subsequently the transfer of these patent rights to Assignee.

Signed at Assignor's office in Hayward, California, this 29th day of January, 2002.

**ALLADVANTAGE.COM (ASSIGNOR):** **ALSET INC. (ASSIGNEE):**

By: John M. Neff By: Reed J. Johnson  
Title: VP, General Counsel Title: CEO

Patent Assignment - Finalized

RECORDED: 07/02/2002 PATENT  
REEL: 012863 FRAME: 0312

Ex. 1 to Defendants' 12(b)(1)  
Motion to Dismiss at 6

# Assignment 4: AllAdvantage.com to Alset, Inc.

- Assigns 17 patents and applications
- The '581 application is not on the list

02/02 TUE 13:39 FAX 2063822669 SPECKMAN LAW GROUP 005

02/02 TUE 13:39 FAX 2063822669 SPECKMAN LAW GROUP 004

**PATENT ASSIGNMENT**

WHEREAS, AllAdvantage.com, a California corporation ("Assignor"), having its place of business at 4010 Point Eden Way Hayward, CA 94545, is the owner of the following patents and patent applications:

Patent Title	Status	Serial Number/ Patent Number
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	08/985,389
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	15377/99
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	2312704
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	98959614.3
Method and Apparatus for Attribute-Based Addressing.	Pending	25623/99
Method and Apparatus for Attribute-Based Addressing.	Pending	99905472.9
Collecting Information About a Computer or Its User.	Pending	24774/99
Collecting Information About a Computer or Its User.	Pending	2318852
Collecting Information About a Computer or Its User.	Pending	99904362.3
Multi-Stage Data Filtering on a Single System.	Pending	09/198,337
Multi-Stage Data Filtering on a Single System.	Pending	16231/99
Multi-Stage Data Filtering on a Single System.	Pending	2312705
Multi-Stage Data Filtering on a Single System.	Pending	98960689.2
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Pending	2,294,124
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Pending	98931419.0
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Issued	5,984,508
Method and Apparatus for Collecting Information regarding a Device or a User of a Device.	Issued	6,236,983

PATENT  
REEL: 012863 FRAME: 0311

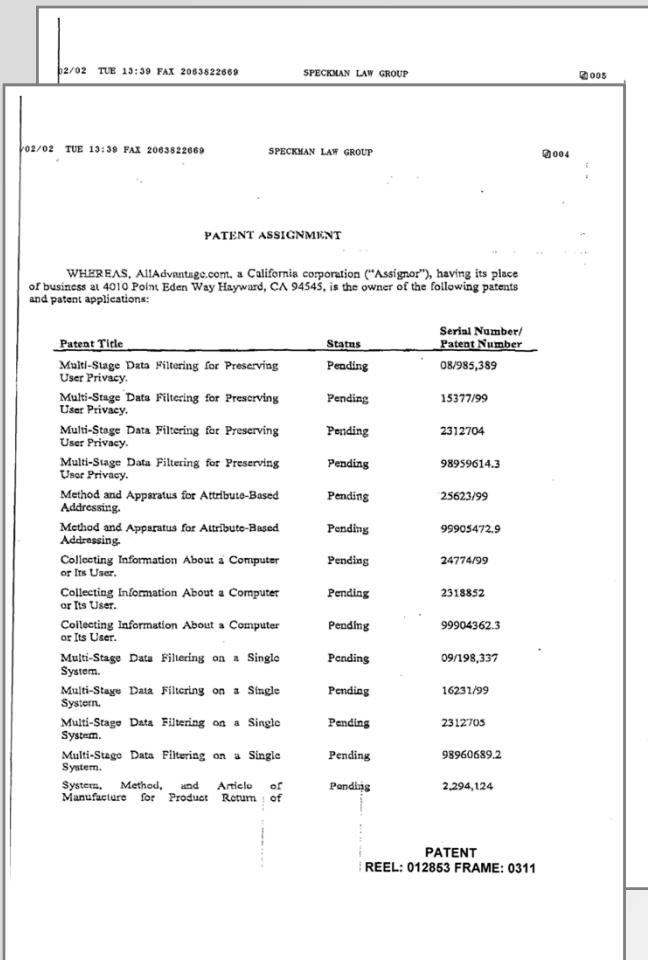
Patent Title	Status	Serial Number/ Patent Number
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	08/985,389
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	15377/99
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	2312704
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	98959614.3
Method and Apparatus for Attribute-Based Addressing.	Pending	25623/99
Method and Apparatus for Attribute-Based Addressing.	Pending	99905472.9
Collecting Information About a Computer or Its User.	Pending	24774/99
Collecting Information About a Computer or Its User.	Pending	2318852
Collecting Information About a Computer or Its User.	Pending	99904362.3
Multi-Stage Data Filtering on a Single System.	Pending	09/198,337
Multi-Stage Data Filtering on a Single System.	Pending	16231/99
Multi-Stage Data Filtering on a Single System.	Pending	2312705
Multi-Stage Data Filtering on a Single System.	Pending	98960689.2
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Pending	2,294,124
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Pending	98931419.0
System, Method, and Article of Manufacture for Product Return of Software and Other Information.	Issued	5,984,508
Method and Apparatus for Collecting Information regarding a Device or a User of a Device.	Issued	6,236,983

Ex. 1 to Defendants' 12(b)(1) Motion to Dismiss at 5-6

Defendants' Rule 12(b)(1) Motion to Dismiss Presentation

# Assignment 4: AllAdvantage.com to Alset, Inc.

- Identifies the '983 patent by title and patent number



Patent Title	Status	Serial Number/ Patent Number
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	08/985,389
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	15377/99
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	2312704
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	98959614.3
Method and Apparatus for Attribute-Based Addressing.	Pending	25623/99
Method and Apparatus for Attribute-Based Addressing.	Pending	99905472.9
Collecting Information About a Computer or Its User.	Pending	24774/99
Collecting Information About a Computer or Its User.	Pending	2318852
Collecting Information About a Computer or Its User.	Pending	99904362.3
Multi-Stage Data Filtering on a Single System.	Pending	09/198,337
Multi-Stage Data Filtering on a Single System.	Pending	16231/99
Multi-Stage Data Filtering on a Single System.	Pending	2312705
Multi-Stage Data Filtering on a Single System.	Pending	98960689.2

Method and Apparatus for Collecting Information regarding a Device or a User of a Device.

Issued

6,236,983

System, Method, and Article of Manufacture for Product Return of Software and Other Information.

Issued

5,984,508

Method and Apparatus for Collecting Information regarding a Device or a User of a Device.

Issued

6,236,983

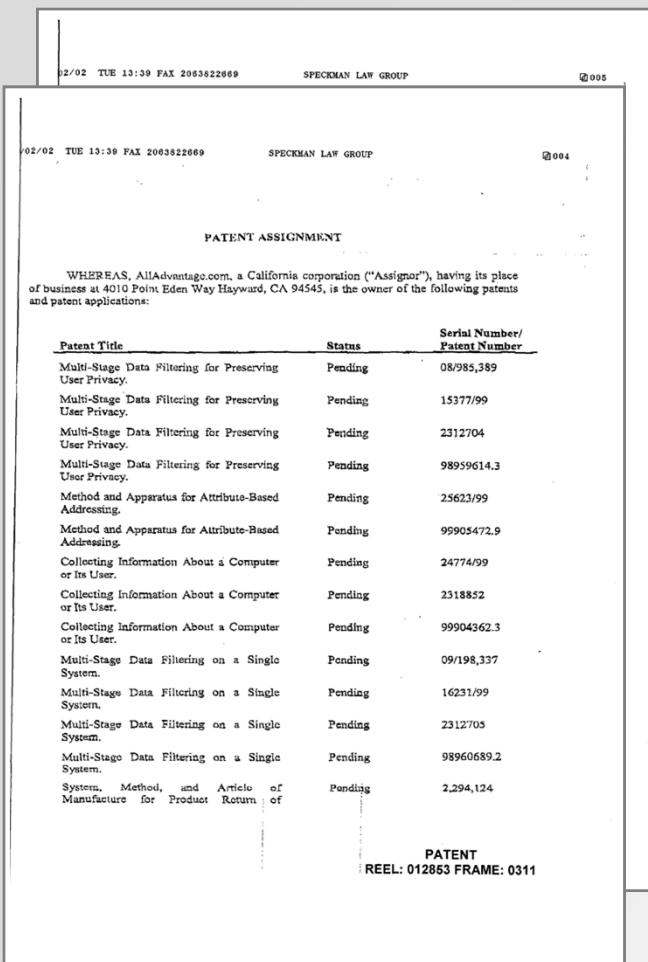
Ex. 1 to Defendants' 12(b)(1) Motion to Dismiss at 5-6

Defendants' Rule 12(b)(1) Motion to Dismiss Presentation



# Assignment 4: AllAdvantage.com to Alset, Inc.

- Identifies three applications related to the '983 patent



Patent Title	Status	Serial Number/ Patent Number
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	08/985,389
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	15377/99
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	2312704
Multi-Stage Data Filtering for Preserving User Privacy.	Pending	98959614.3
Method and Apparatus for Attribute-Based Addressing.	Pending	25623/99
Method and Apparatus for Attribute-Based Addressing.	Pending	99905472.9
Collecting Information About a Computer or Its User.	Pending	24774/99
Collecting Information About a Computer or Its User.	Pending	2318852
Collecting Information About a Computer or Its User.	Pending	99904362.3
Multi-Stage Data Filtering on a Single System.	Pending	09/198,337
Multi-Stage Data Filtering on a Single System.	Pending	16231/99
Manufacture for Product Return of Software and Other Information.	Issued	6,236,983
Method and Apparatus for Collecting Information regarding a Device or a User of a Device.		

Ex. 1 to Defendants' 12(b)(1) Motion to Dismiss at 5-6

Defendants' Rule 12(b)(1) Motion to Dismiss Presentation

# Assignment 4: AllAdvantage.com to Alset, Inc.

- Agreement does not assign “any continuations” of the listed patents, nor does it assign the “invention” described in the patents.
- Assignment language:

WHEREAS, Alset Inc., a Delaware corporation (“*Assignee*”), having its principal place of business at 555 Bryant Street #307, Palo Alto, CA 94301, is desirous of acquiring said patents, NOW THEREFORE, for good and valuable consideration, receipt of which is hereby acknowledged, Assignor, does hereby assign unto Assignee, all right, including common law rights, title and interest in the United States of America, Canada, the European Union, and all other countries and jurisdictions of the world in and to said patents together with the goodwill of the business symbolized by said patents and applications and registrations thereof.

Ex. 1 to Defendants' 12(b)(1) Motion to Dismiss at 6

# Assignment 5: Alset, Inc. to Expeditionary Sound

- Alset Inc. purported to assign the '983 and '581 patents to Expeditionary Sound on February 7, 2005

**ASSIGNMENT OF PATENT RIGHTS**

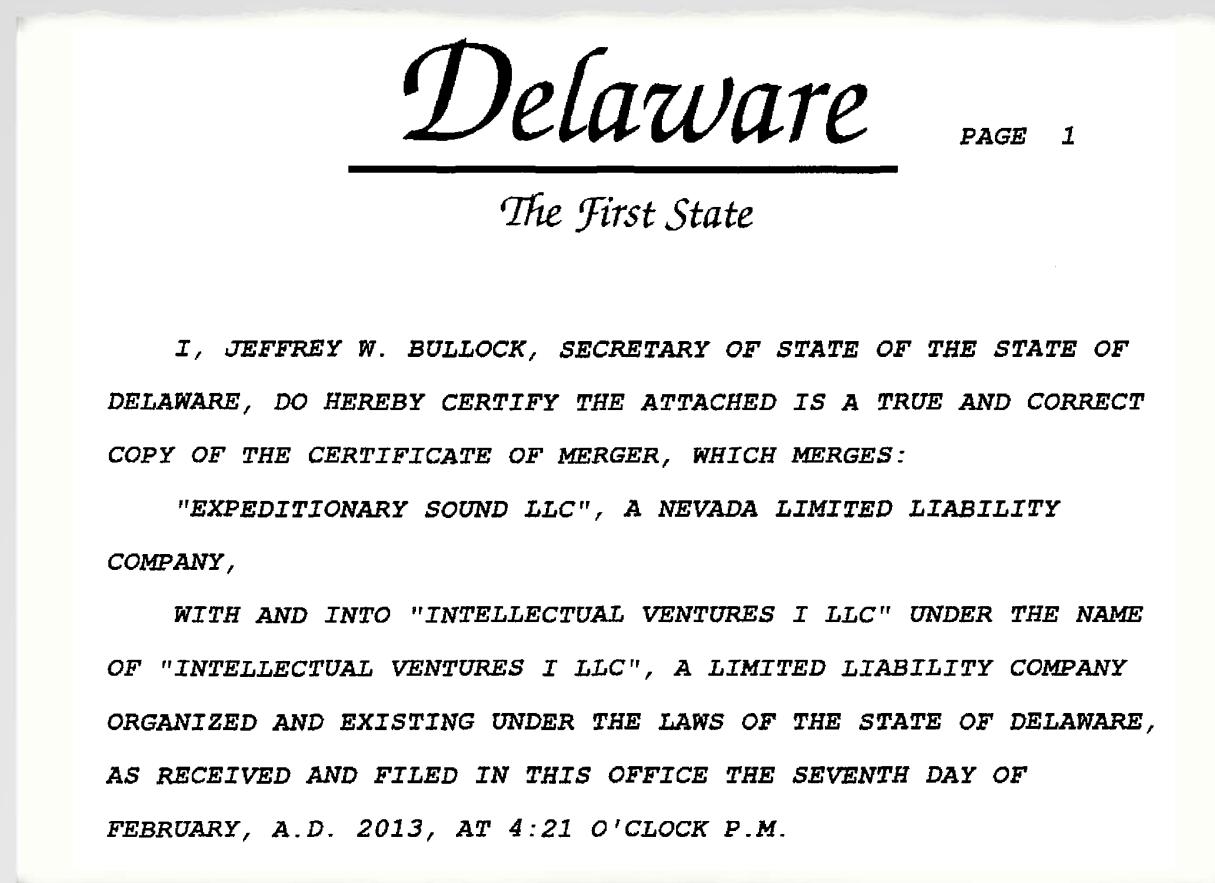
For good and valuable consideration, the receipt of which is hereby acknowledged, Alset, Inc. having offices at 555 Bryant Street, Palo Alto, CA 94301, ("Assignor"), does hereby sell, assign, transfer and convey unto Expeditionary Sound LLC, a Nevada limited liability company, having an office at 2215-B Renaissance Drive, Suite 5, Las Vegas, NV 89119 ("Assignee") or its designees, all of Assignor's right, title and interest in and to the patents listed below and the inventions disclosed in any of the foregoing, any and all counterpart United States, international and foreign patents, applications and certificates of invention based upon or covering any portion of the foregoing, and all reissues, re-examinations, divisionals, renewals, extensions, provisionals, continuations and continuations-in-part of any of the foregoing (collectively, "Patent Rights").

<u>Patent or Application No.</u>	<u>Country</u>	<u>Filing Date</u>	<u>Title and Inventor(s)</u>
6,236,983	US	1/31/1998	Method and apparatus for collecting information regarding a device or a user of a device
6,519,581	US	4/27/2001	Collection of information regarding a device or a user of a device across a communication link

Ex. 8 to Defendants' 12(b)(1) Motion to Dismiss at 4

# Assignment 6: Expeditionary Sound to Intellectual Ventures

- Expeditionary Sound and Intellectual Ventures merged on February 7, 2013



Ex. 9 to Defendants' 12(b)(1) Motion to Dismiss at 5

# Burden of Proof

- A plaintiff who brings suit for patent infringement “has the burden to show necessary ownership rights [in the asserted patent(s)] to support standing to sue.” *Abbott Point of Care Inc. v. Epocal, Inc.*, 666 F.3d 1299, 1302 (Fed. Cir. 2012)
- If the plaintiff does not own the patent, “the suit must be dismissed, and the jurisdictional defect cannot be cured after the inception of the lawsuit.” *Abraxis Bioscience, Inc. v. Navinta LLC*, 625 F.3d 1359, 1364 (Fed. Cir. 2010)
- IV must show ownership of the patent by a “clear and unmistakable” intent to transfer the ’581 patent. *Univ. Patents, Inc. v. Kligman*, 762 F. Supp. 1212, 1219 (E.D. Pa. 1991)

# Burden of Proof

- Defendants do not have an “elevated burden” to prove that the ’581 patent was not transferred.
- IV confuses the distinction between the *validity* of an assignment and its *effect/meaning*.
  - “While recording [an assignment with the Patent and Trademark Office] creates a presumption in [Plaintiff’s] favor if the validity of the Agreement is challenged, *it has no bearing on the question of what substantive rights were actually transferred*” *Clouding IP, LLC v. Google Inc.*, No. CV 12-639-LPS, 2014 WL 3767489 at \*5 n.12 (D. Del. July 28, 2014)
- Courts examine the meaning of assignments without assigning a burden of proof.
  - *DDB Techs., LLC v. MLB Advanced Media, LP*, 517 F.3d 1284, 1290 (Fed. Cir. 2008); *Euclid Chem. Co. v. Vector Corrosion Techs.*, 561 F.3d 1340, 1348-50 (Fed. Cir. 2009); *Gerber Sci. Int’l, Inc. v. Satisloh AG*, Civ. No. 3:07-CV-1392, 2009 U.S. Dist. LEXIS 79690, at \*13-14 (D. Conn. Sept. 2, 2009)

# Language in AllAdvantage Patent Assignment Does Not Transfer the '581 Patent

- IV is relying on two phrases of the AllAdvantage to Alset Patent Assignment language to transfer the '581 patent:
  1. “all... rights, title and interests. . . in and to *said patents*”
  2. “together with the goodwill of the business symbolized by said patents and applications and registrations thereof”

# “Said Patents” Do Not Include the ’581 Patent Application

- “Automatic” transfer of children patents occurs only through the transfer of “ideas” or “inventions”. The AllAdvantage Patent Assignment transferred an *issued* patent only.
  - *DDB Techs., LLC v. MLB Advanced Media, LP*, 517 F.3d 1284, 1287 (Fed. Cir. 2008), *Gerber Sci. Int'l, Inc. v. Satisloh AG*, Civ. No. 3:07-CV-1392, 2009 U.S. Dist. LEXIS 79690, at \*13-14 (D. Conn. Sept. 2, 2009), *E.I. Du Pont de Nemours & Co. v. Okuley*, Civ. No. C2-97-1205, 2000 U.S. Dist. LEXIS 21385, at \*80 (S.D. Ohio Dec. 21, 2000).
- At the time of assignment, the ’581 application had been filed with the PTO and was known to the parties.
  - Patent applications are treated the same as issued patents for assignment purposes. 35 U.S.C. § 261.

# “Goodwill” Does Not Include the ’581 Patent Application

- Goodwill is an asset that does not include patents.
  - *Weston Anson, The Intangible Assets Handbook 7* (ABA Section of Business Law 2007).
- Goodwill is “the value ‘beyond the mere value of the capital, stock, funds, or property employed therein’ associated with continued patronage.” *Deseret Mgmt. Corp. v. United States*, 112 Fed. Cl. 438, 449 (2013)

# Under California Law Parol Evidence Should Not Be Admitted to Vary the Agreement

- The first step, under California Law, is to consider the terms of the contract. Cal. Civ. Code § 1638 (2015).
- The Court may look at (without admitting) extrinsic evidence to determine whether the meaning of a specific contract term is “reasonably susceptible” to a party’s proposed interpretation—*i.e.*, whether particular words of the written contract are ambiguous.
- The Court cannot *add* language to the contract
  - *Curry v. Moody*, 40 Cal. App. 4th 1547, 1554 (1995) (“[E]xtrinsic evidence cannot be used to show that when the parties said ‘Bunker Hill Monument’ they meant ‘the Old South Church’ or that when they said ‘pencils’ they really meant ‘car batteries.’”)
  - *Winet v. Price*, 4 Cal. App. 4th 1159, 1165 (1992)

# Parol Evidence Does Not Support the Transfer of the '581 Patent

- IV offers only 3 pieces of parol evidence, which provide no evidence of whether AllAdvantage transferred the '581 Patent.
  - Declaration of Paul Hurley
  - Benado Testimony
  - Actions of AllAdvantage and Alset

# The Hurley Declaration Should be Stricken from the Record

- Defendants requested an identification of any additional extrinsic evidence on which IV planned to rely. IV made no response to this request.

**From:** Lantier, Gregory  
**Sent:** Monday, February 02, 2015 2:03 PM  
**To:** Derek Gilliland  
**Cc:** Christian A. Hurt; Robert L. Wagner; VERNON M. WINTERS; Russell E. Cass; Ross Leonoudakis; John Ebken; Pearson, Leslie; Marcus, David; Crudo, Richard; Grewal, Monica; Robert Winn Cutler; Ben King; Kirk Voss; Pam Ridgell; Edward Chin; Michelle Button; Debbi Lowe; Moni King; Henry Sneath; Andrew Wright  
**Subject:** RE: Intellectual Ventures v. Erie and Highmark: Patent Ownership Issue

Derek:

We intend to depose Ms. Benardo, based on our understanding that Intellectual Ventures will rely upon her testimony as extrinsic evidence of the meaning of the assignment from AllAdvantage to Alset. Are you

We understand that, at present, Intellectual Ventures also plans to rely upon the recordation of the AllAdvantage to Alset assignment at the PTO as extrinsic evidence. If there is any additional extrinsic evidence underlying Intellectual Ventures' contention that it is owner of the '581 patent, please let me know as soon as possible, so that we can take any necessary discovery.

In addition, based on our prior exchange, I do not believe that there are additional documents in Intellectual Ventures' possession or control that bear on the ownership issue. If there are any such documents, please let me know and also confirm that Intellectual Ventures make those documents available so that defendants can include them in their opening brief and take any needed discovery with respect to any such documents. We have the certified file history of the '581 patent, so this is limited to any documents not included there.

Greg

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Email from G. Lantier to D. Gilliland. Dkt. 82-1

# The Hurley Declaration Should be Stricken from the Record

- The Hurley Declaration is hearsay. Defendants have not had an opportunity to cross-examine Mr. Hurley regarding:
  - His knowledge of the '581 patent.
  - His relationship to AllAdvantage.com and Sherwood Partners.
  - His involvement in the relevant negotiations.
- The Hurley Declaration is hearsay within hearsay.
  - Paul Hurley has no ownership, employee or any other business relationship to or with AllAdvantage or Sherwood. He cannot know what the intention of AllAdvantage or Alset was.
- Paul Hurley has no direct knowledge of the intent of AllAdvantage.

# The Hurley Declaration Should Not Be Credited

- The Hurley Declaration contains only a conclusory statement, unsupported by any corroborating facts
  - Devoid of any detail that would enable the Court to determine whether to credit his conclusory statements.

I, Paul Hurley, declare:

1. I have personal knowledge of the facts set forth in this Declaration. I am competent to testify to all matters stated, and I am not under any legal disability that would in any way preclude me from testifying.
2. I was the founder of Aveo, Inc. and Chief Executive Officer from October 1997 to April

6. It was the intent of the Aveo, Inc. to Sherwood Partners, Inc. assignment to transfer all of Aveo, Inc.'s assets to Sherwood Partners, Inc.
7. It was the intent of the Alladvantage.com to Alset, Inc. assignment to transfer to Alset, Inc. all assets previously owned by Aveo, Inc.

Aveo, Inc.'s assets to Sherwood Partners, Inc.

7. It was the intent of the Alladvantage.com to Alset, Inc. assignment to transfer to Alset, Inc. all assets previously owned by Aveo, Inc.
8. I declare under penalty of perjury that the foregoing statements are true to the best of my knowledge.

Executed on March 26, 2015.

  
Paul Hurley

Hurley Declaration

# The Hurley Declaration Should Not Be Credited

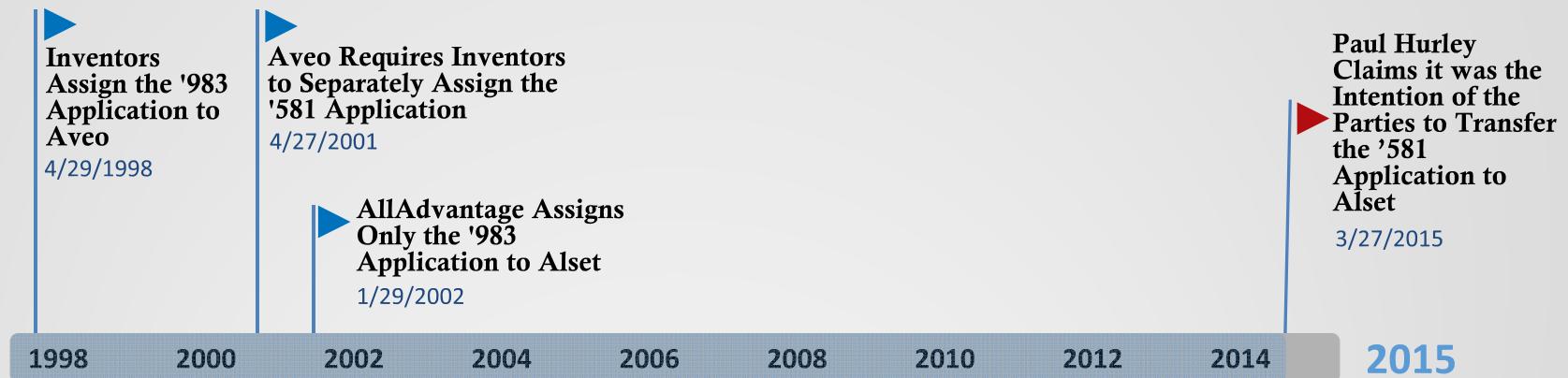
- The Hurley Declaration is contrary to the actions of the parties.
- When the '581 patent was filed on April 27, 2001, Aveo (through its CEO, Paul Hurley) required that the inventors execute a separate assignment of the '581 application.
  - In 1998, the co-inventors assigned the '983 Patent Application.
  - In 2001, the co-inventors separately assigned the '581 Patent Application and transferred it by name.

and its successors, assigns, and legal representatives, the entire right, title, and interest for the United States and all foreign countries, in and to any and all improvements that are disclosed in the application for the United States patent that has been executed by the undersigned prior hereto or concurrently herewith on the dates indicated below and is entitled COLLECTION OF INFORMATION REGARDING A DEVICE OR A USER OF A DEVICE ACROSS A COMMUNICATION LINK,  
and in and to said application and all divisional applications, continuation applications, continued prosecution applications, continuation-in-part applications, substitute applications, renewal applications, reissue applications, reexaminations, extensions, and all other patent applications that have been or shall be filed in the United States and all foreign countries on any of said improvements; and in and to all original patents, reissued patents, reexamination certificates, and extensions, that have been or shall be issued in the United States and all foreign countries on said improvements; and in and to all rights of priority resulting from the filing of said United States application;

Ex. 3 to Defendants' 12(b)(1) Motion to Dismiss at 5

# The Hurley Declaration Should Not Be Credited

- 9 months after the separate transfer of the '581 patent from the inventors to Aveo, the parties did not separately assign the '581 application from AllAdvantage to Alset and only assigned the '983 patent.
- *13 years later*, Paul Hurley is declaring that the '581 patent was transferred from AllAdvantage to Alset.



# The Benado Deposition

- IV cites to the testimony of Lisa Benado, prosecuting attorney of the '581 Patent. She has no contemporaneous knowledge of the parties' intent:

4 Q. Looking at the Asset Purchase Agreement, did you  
5 draft that Asset Purchase Agreement?  
6 A. No, I did not.  
7 Q. Do you recall who drafted it?  
8 A. I have no knowledge of who drafted this.  
9 Q. While working on prosecuting the -581 patent,  
10 did you review that document?  
11 A. Yes, I did.  
12 Q. While prosecuting the -581 patent -- excuse me,  
13 patent, did you have any involvement in negotiating that  
14 agreement?  
15 A. No, I did not.  
16 Q. Did you have any involvement in executing that  
17 agreement?  
18 A. No, I did not.  
19 Q. Do you know who the parties were at AllAdvantage  
20 that were involved in drafting that agreement?  
21 A. I do not know.  
22 Q. Do you know who the parties were involved at  
23 Sherwood in drafting that agreement?  
24 A. I don't.

2 2002, did you speak to anyone at AllAdvantage about  
3 drafting that document?  
4 A. No, I did not.  
5 Q. At that time the document was prepared in 2002,  
6 did you speak to anyone at Sherwood about drafting that  
7 agreement?  
8 A. No, I did not.  
9 Q. Do you have any recollection of who was involved  
10 from AllAdvantage in negotiating that agreement?  
11 A. No, I do not.  
12 Q. Any knowledge of who was involved from Sherwood  
13 in negotiating that agreement?  
14 A. No, I don't.

Benado dep. 77:4-78:14

# The Parties' Post-Transfer Actions After the Execution of the Assignment

- Often a Plaintiff that is later found not to own the patent will have prosecuted its application and taken similar steps.
  - *See, e.g., Bd. of Trust. of Leland Stanford v. Roche Sys.*, 131 S. Ct. 2188, 2199 (2013) (finding Defendant to be proper owner of patents at issue, despite the fact that plaintiff filed for, prosecuted, and asserted patents at issue); *Ultra-Temp Corp. v. Advanced Vacuum Sys., Inc.*, 189 F.R.D. 17, 25 (D. Mass. 1999) (finding plaintiff not to be the proper owner of the patent at issue, despite plaintiff's prosecution of the patent); *Mayfair Wireless LLC v. Cellco P'ship*, No. cv 11-772-SLR-SRF, 2013 WL 4657507, at \*4-5 (D. Del. Aug. 30, 2013) (infringement action dismissed for lack of subject matter jurisdiction due to a break in the chain of title, despite the fact that alleged assignee took responsibility for the prosecution of the patent at issue)
- The words of the assignment document govern.